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| 10/039,632      | 10/26/2001  | Robert F. Friedman   | 2102462-991101      | 1596             |

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EXAMINER

BOCURE, TESFALDET

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2631

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039,632

Applicant(s)

FRIEDMAN, ROBERT F.

Examiner

Tessfaldet Bocure

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,9-12,18-23 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9-12,18-23 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "sub channel divider, timing generator, signal and signal combiner" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The status of the patent US patent application Serial No. 09/438,865 disclosed in page one of the specification should be updated as---now issued as US patent No. 6,452,989 on September 2002.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-12 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11: "the controller" in line 3, "the tuner" in line 4 and "the frequency-separated periodic signal" in line 4, lack clear antecedent basis.

It seems applicant is trying to further limit claim subject matter belonging to a receiver which is not claimed in the independent claim, claim 9.

Claim 12: Claim 12 is inherently rejected as being dependent on the rejected base claim, claim

11.

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Claim 22: "the periodic signal associated with particular subchannel transmitted in four separate frequency allocation but **on** one satellite---," in claim 22 is not clear from the claim. Do you mean that the four separate subchannels are transmitted **to** one satellite?

Claim 23: Claim 23 is inherently rejected as being dependent on the rejected base claim, claim 22.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4,9,10,18-21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Schiff** (US patent number 6,424,831).

**Schiff** teaches a gateway (120 and 122 in fig. 3) for communicating with a plurality user units (124 and 126) via satellite transponders (116 and 118 in fig. 1) comprising: transmitting the information signal on a frequency division multiplexing, where the frequency band carrying the information signal are divided into sub channels (see col. 6, lines 26-68); a control processor (320) for generating a timing information to each of the sub channels; modulator (326) for modulating the information signal by the sub channels; up-converter, amplifier (not shown but embedded with the transmitter 338) and transmitting antenna (338) for transmitting the signal to either one of the satellite transponder or to both of them using either a single antenna or plurality of antennas as in claims 1,9,18 and 34.

Even though does not show that the timing signal generated by the control processor is added to each of the sub channels carrying the information signal as in claim 1,9,18 and 34, it obvious and well known that the timing information generated should be added to each of the sub channel carrying the information signal in order to be used by the user terminal to detect the received signal properly.

Therefore, it would have been obvious to one of an ordinary skill in the art to add the timing generated by

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the processor into the sub channels carrying the information signal in order to detect the data properly at the time the invention was.

Further claims 3 and 20, Schiff shows that the sub channels and timing information generated by the control unit (320) are transmitted from the gateway to the user terminal (124 and 126) *via* the satellite transponders (116 and 118).

Even though **Schiff** does not show that the satellite transponders (116 and 116) are located on one satellite as in claims 2,4,10,19 and 21, it is well known that the satellite transponder for repeating the signal transmitted from the gateway to user terminal can be belong to one satellite or different satellite depending on the distance the signal to be transmitted from the gateway and the user terminal. Therefore it would have been obvious to one of an ordinary skill in the art to locate the satellite transponder **Schiff** be located on one place belonging to one satellite at the time the invention was made.

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-3,9-12,18-23 and 34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3,9-12,18-23 and 34 of copending Application No. 10/230,661. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner cannot substantiate the difference between the disclosed and claimed subject matter in the instant application from that of the copending Application Serial No. 10/230,661.

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**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patent numbers 4,901,307; 5233,626; 5859,874; 5,867,109; 5,987,037; 6,067,442 and 6,154,501 issued to Gilhousen, Ames, Weidman, Gans, Weidman et al. and Friedman respectively disclose a transmission system for transmitting between plurality of user using satellite transponders.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tesfaldet Bocure whose telephone number is (703) 305-4735. The examiner can normally be reached on Mon-Thur (7:30a-5:00p) & Mon.-Fri (7:30a-5:00p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (703) 305-4378. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 305-3988 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Tesfaldet Bocure  
Primary Examiner  
Art Unit 2631



T.Bocure  
February 7, 2003